



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/541,157	06/30/2005	Son Nguyen-Kim	13111-00023-US	6306
30678 7590 03/30/2009 CONNOLLY BOVE LODGE & HUTZ LLP 1875 EYE STREET, N.W. SUITE 1100 WASHINGTON, DC 20006				
EXAMINER PEZZUTO, HELEN LEE				
ART UNIT		PAPER NUMBER		
1796				
MAIL DATE		DELIVERY MODE		
03/30/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/541,157

Applicant(s)

NGUYEN-KIM ET AL.

Examiner

Helen L. Pezzuto

Art Unit

1796

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 04 March 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 30, 31 and 36-47.
Claim(s) withdrawn from consideration: 1-15, 27-29.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). filed on 1/13/09
13. ☐ Other: _____.

/Helen L. Pezzuto/
Primary Examiner
Art Unit: 1796

Continuation of 11, does NOT place the application in condition for allowance because: Applicant's remarks filed under 37 CFR 1.116 on 3/4/09 have been fully considered. The crux of applicant's argument is repeated and was previously addressed in the Final Office action mailed 11/5/08. Firstly, applicants urge prior art do not require an anionic and cationic components be used together, and further urge they do not specify the recited ratio of anionic to cationic components. Jenkins teaches 1-99.8 wt% "at least one or more" nonionic, cationic, anionic monomers, and up to 99.8 wt% of one or more monoethylenically unsaturated monomers. The instant anionic and cationic monomers fall within those of prior art anionic and cationic monomers. The instant amide group containing monomer is disclosed as suitable monoethylenically unsaturated monomers (col. 3, lines 64-65). Galleguillos et al. discloses 0.05 to 20 mol% of at least one carboxy-functional group-containing monomer within the scope of the instant anionic monomer, 10-45 mole% of at least one amino group-containing monomer within the scope of the instant cationic monomer, and hydrophobic monomer. The instant amide group-containing monomer is taught within the scope of prior art cationic monomer (col. 6, line 5) and nonionic hydrophilic monomer (col. 7, lines 44-45, 48-49, col. 10, line 60). Blackenburg et al. discloses 50-99.9 wt% of ethylenically unsaturated monomers within the scope of the instant cationic, anionic and amide group-containing monomers. The recited amide group-containing monomer is clearly taught (col. 3, lines 60-61; col. 5, line 16). Morschhauser et al. teach inter alia, 0.1-99.9 mol% of one or more ethylenically unsaturated comonomers within the scope of the instant anionic, cationic, and amide group-containing monomers. Thus, the instant copolymer is clearly taught in prior art disclosures. Secondly, applicants urge every example of Galleguillos et al. has the molar amount of cationic component exceeding the molar amount of anionic component. The examiner is of the position that prior art disclosure is not limited to just the exemplified or preferred embodiments, the reference disclosure renders obvious embodiments within 0.05-20 mol% anionic monomer and 10-45 mole% cationic monomers. Finally, applicants urge that one has to choose the recited amide group-containing compound among long lists of ethylenically unsaturated monomers disclosed in the prior art reference. The examiner is of the position that it is well settled that it is prima facie obvious to the skilled artisan to indiscriminately choose some among the many disclosed by the prior art, so long as the reference teaches that any one will work. Accordingly, the examiner's position is maintained.